



Commissioner for Patents
Washington, DC 20231
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Memorandum

DATE: April 29, 2002

TO: Technology Center Directors
Patent Examining Corps

FROM: Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

SUBJECT: Reliance upon abstracts and foreign language documents in support of a rejection

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: (1) a rejection is supported in whole or part by an abstract without reference to the underlying document, except in those rare situations where the abstract qualifies as prior art but the underlying document does not (or is non-existent); or (2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English. An example of a situation where the abstract qualifies as prior art but the underlying document does not is as follows:

- An "abstract" describing certain subject matter, which is the subject of a not-yet completed scientific paper, is prepared and publicly distributed on a date in advance of an event at which the rest of the subject matter in the scientific paper is to be unveiled. In the course of time, the event occurs and the subject matter in the scientific paper is made public by publication of the scientific paper. In this instance, as to an application under examination, the difference in publication dates could make the abstract prior art as a printed publication and the scientific paper not prior art as a printed publication.

Evidence uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document.

Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).

To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection.

The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency.

When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP 706.07(a).

Experience at the Board of Patent Appeals and Interferences indicates that consideration of an English language version of the underlying document instead of the abstract aids in the resolution of the patentability issues raised in an appeal. Many cases would not have gone to appeal had the examiner obtained the full text of the underlying document and any needed translation and considered the patentability of the claims in light of the fuller set of facts.

All participants in an appeal conference should review the appealed rejections to ensure that if an abstract is relied upon as evidence to support the rejection, the full text document and any needed translation has been obtained and considered. It should be a rare occurrence that an Examiner's Answer is prepared where a rejection is based upon an abstract rather than the underlying document. The record needs to make clear that efforts to obtain the underlying document were unsuccessful (e.g., because there is no underlying document or the date of the underlying document does not qualify as prior art). Under those circumstances, the abstract will constitute the best evidence available and the patentability issues will have to be resolved on the facts described in the abstract.

706.02

RELIANCE UPON ABSTRACTS AND FOREIGN LANGUAGE DOCUMENTS IN SUPPORT OF A REJECTION

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection.

An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a).<